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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,017	11/24/2003	Shuji Fujii	PRON: 002	9160
27890 7590 06/01/2007 STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			EXAMINER LEE, JINHEE J	
			ART UNIT 2174	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/719,017

Applicant(s)

FUJII, SHUJI

Examiner

Jinhee J. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007 and 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4-6 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Wells et al. (2264685).

Re claim 4, Wells et al. discloses a polymer insulator apparatus comprising a rigidly and unrotatably connected rectangular structure comprising plural polymer post insulators (1), a supporting structure (3 for example) and a plate member (2 for example) including a conductor mounting portion of the plate member comprising a substantially longitudinal portion configured for supporting a conductor (bolts are conductors for example, furthermore, the holes in the plate that hold the bolts are capable of supporting many other types of conductors as well) wherein a first end of each polymer post insulator is rigidly and unrotatably connected to said supporting structure, and a second end of each said polymer post insulator is rigidly and unrotatably connected to said plate member, (see figure 1 for example).

Re claim 5, Wells et al. discloses a method for mounting plural polymer post insulators on a supporting structure, comprising: providing a supporting structure (3), a plate member (2 for example) including a conductor mounting portion of the plate member comprising a substantially longitudinal portion configured for supporting a

conductor, and plural polymer post insulators (1); rigidly and unrotatably connecting a first end of each said plural polymer post insulator to the supporting structure; and rigidly and unrotatably connecting a second end of each said plural polymer post insulator to said plate member whereby said plural polymer post insulators are parallel to each other and normal to the supporting structure, thereby forming a rigidly and unrotatably connected rectangular structure (see figure 1). Note that it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Re claim 6, Wells et al. discloses a method wherein said first end of each said polymer post insulator is connected to said supporting structure by a first rigid body (unnumbered, bottom plate for example) comprising a part of said polymer post insulator, and said second end of each said polymer post insulator is connected fixedly (bolts, 4,5) to said plate member by a second rigid body (unnumbered, top plate for example) comprising a part of said polymer post insulator (see figure 1).

Re claim 9, Wells et al. discloses a polymer insulator apparatus wherein said supporting structure is configured for operating with an electric power transmission line (see figure 1 for example).

Re claim 10, Wells et al. discloses a method wherein said supporting structure is configured for operating with an electric power transmission line (see figure 1 for example).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 11 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al. in view of Locke (US000872569).

Re claim 8, Wells et al. substantially discloses a method as set forth in claim 5 above except wherein when an axial direction along a length of each said plural polymer post insulator is substantially a horizontal direction and an axial direction along a length of said supporting structure is substantially a vertical direction, then said plural polymer post insulators are for supporting a weight of a load of a conductor acting in the vertical direction. However, Locke teaches of wherein when an axial direction along a length of each said plural polymer post insulator is substantially a horizontal direction and an axial direction along a length of said supporting structure is substantially a vertical direction, then said plural polymer post insulators are for supporting a weight of a load of a conductor acting in the vertical direction (see figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use arrangement of Locke with the insulators of Wells et al. in order to provide the vertical arrangement.

Re claim 11, Wells et al. substantially discloses a polymer insulator apparatus comprising a rigidly and unrotatably connected rectangular structure comprising plural

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polymer post insulators (1), a supporting structure (3) and a plate member (2) including a conductor mounting portion of the plate member comprising a substantially longitudinal portion configured for supporting a conductor, wherein a first end of each polymer post insulator is rigidly and unrotatably connected to said supporting structure, and a second end of each said polymer post insulators is rigidly and unrotatably connected to said plate member. Wells et al. does not explicitly disclose wherein said supporting structure is selected from the group consisting of a steel pole, a wood pole or a steel tower. However, Locke teaches of supporting structure selected from the group consisting of a steel pole, a wood pole or a steel tower (see figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use supporting structure selected from the group consisting of a steel pole, a wood pole or a steel tower of Locke with the insulators of Wells et al. in order to provide the supporting structure for the insulators.

Re claim 12, Wells et al. substantially discloses a method for mounting plural polymer post insulators on a supporting structure, comprising: providing a supporting structure (3), a plate member including a conductor mounting portion of the plate member comprising a substantially longitudinal portion configured for supporting a conductor, and plural polymer post insulators (1); rigidly and unrotatably connecting a first end of each said plural polymer post insulator to the supporting structure; and rigidly and unrotatably connecting a second end of each said plural polymer post insulator to said plate member whereby said plural polymer post insulators are parallel to each other and normal to the supporting structure, thereby forming a rigidly and

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unrotatably connected rectangular structure. Wells et al. does not explicitly disclose wherein said supporting structure is selected from the group consisting of a steel pole, a wood pole or a steel tower. However, Locke teaches of supporting structure selected from the group consisting of a steel pole, a wood pole or a steel tower (see figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use supporting structure selected from the group consisting of a steel pole, a wood pole or a steel tower of Locke with the insulators of Wells et al. in order to provide the supporting structure for the insulators. Note that it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Re claim 13, Wells et al. substantially discloses an apparatus as set forth in claim 4 above except wherein the supporting structure to which the first ends of the polymer post insulators are connected, is substantially vertical. However, Locke teaches of wherein the supporting structure to which the first ends of the polymer post insulators are connected, is substantially vertical (see figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use wherein the supporting structure to which the first ends of the polymer post insulators are connected, is substantially vertical arrangement of Locke with the insulators of Wells et al. in order to provide the vertically arranged insulators.

Re claim 14, note that Locke discloses wherein the supporting structure to which the first ends of the polymer post insulators are connected, is substantially vertical.

Re claim 15, Wells et al. substantially discloses a method as set forth in claim 5 above except wherein the supporting structure to which the first ends of the polymer post insulators are connected, is substantially vertical. However, Locke teaches of wherein the supporting structure to which the first ends of the polymer post insulators are connected, is substantially vertical (see figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use wherein the supporting structure to which the first ends of the polymer post insulators are connected, is substantially vertical arrangement of Locke with the insulators of Wells et al. in order to provide the vertically arranged insulators.

Re claim 16, note that Locke discloses wherein the supporting structure to which the first ends of the polymer post insulators are connected, is substantially vertical.

### ***Response to Arguments***

5. Applicant's arguments filed 1/10/07 have been fully considered but they are not persuasive.

In response to applicant's arguments that the prior art does not teach "a conductor mounting portion of the plate member comprising a substantially longitudinal portion configured for supporting a conductor", examiner disagrees. The plate 2 supports bolts, which are conductors. Furthermore, the holes holding the bolts are capable of holding many other types of conductors.

Furthermore, in response to the Applicant's argument that Weiner's intended use is different than the applicant's invention, it has been held that a recitation with respect



to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both prior arts are used to support insulators.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-2100 ext. 74. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jinhee J Lee  
Primary Examiner  
Art Unit 2174

A handwritten signature in black ink, appearing to read 'Jinhee J Lee', with a long horizontal flourish extending to the right.

jji